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OFFICE OF PETITIONS

In re Application of	:	
Berthelette et al.	:	DECISION ON APPLICATION
Application No. 10/502,380	:	FOR
Filed: January 28, 2005	:	PATENT TERM ADJUSTMENT
Attorney Docket No. MC055P	:	

This is a decision on the "PETITION PURSUANT TO 37 C.F.R. §1.181 and APPLICATION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705(b)" filed June 12, 2007. Applicants request reinstatement of all or part of the term that was reduced pursuant to 1.704(b), namely twenty-six (26) days.

The application for patent term adjustment is **DISMISSED**.

On April 4, 2007, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 73 days. On June 12, 2007, applicants timely[1] submitted an application for patent term adjustment (with required fee), asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance was 525 days. Petitioner argues that in spite of all due care, applicants were unable to reply to the rejection within three months of the mailing date of the Office action.

Applicants state that no terminal disclaimer has been filed or is required.

37 CFR § 1.704(b) provides that:

[1] PALM records indicate that the Issue Fee payment was received on June 22, 2007.

> With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

It is undisputed that applicants did not file a response to the Office action mailed November 3, 2006 until March 1, 2007, three months and 26 days later. Accordingly, pursuant to § 1.704(b), the period of adjustment was properly reduced by 26 days, the number of days, beginning on February 4, 2007, the day after the date that is three months after the date of mailing of the non-final Office action, and ending on March 1, 2007, the date of filing of the reply.

As stated in MPEP 2734,

37 CFR 1.705(c) implements the provisions of 35 U.S.C. 154(b)(3)(C) and specifically provides that a request for reinstatement of all or part of the period of adjustment reduced pursuant to 37 CFR 1.704(b) for failing to reply to a rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request must include:

> (1) the fee set forth in 37 CFR 1.18(f); and (2) a showing to the satisfaction of the Director that, in spite of all due care, the applicant was unable to reply to the rejection, objection, argument, or other request within

> three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request. 37 CFR 1.705(c) also provides that the Office shall not grant any request for reinstatement for more than three additional months for each reply beyond three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request (35 U.S.C. 154(b)(3)(C)).

Filing a reply outside of three months after an Office action is per se a failure to engage in reasonable efforts to conclude prosecution under 35 U.S.C. 154(b)(2)(C)(ii) unless applicant can establish that the delay was "in spite of all due care."

The Office "shall reinstate all or part of the cumulative period of time of an adjustment reduced under [35 U.S.C. 154(b)(2)(C)] if the applicant… makes a showing that, in spite of all due care, the applicant was unable to respond within the 3-month period…." See 35 U.S.C. 154(b)(3)(C). The "due care" of a reasonably prudent person standard has been applied in deciding petitions under the "unavoidable delay" standard of 35 U.S.C. 133. See In re Mattullath, 38 App. D.C. 497, 514-15 (1912) ("the word unavoidable' … is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business") (quoting and adopting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33); see also Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) ("in determining whether a delay…was unavoidable, one looks to whether the party…exercised the due care of a reasonably prudent person"). While the legislative history of the American Inventors Protection Act of 1999 is silent as to the meaning of the phrase "in spite of all due care," the phrases "all due care" and "unable to respond" invoke a higher degree of care than the ordinary due care standard of 35 U.S.C. 133, as well as the "reasonable efforts to conclude processing or examination [or prosecution] of an application" standard of 35 U.S.C. 154(b)(2)(C)(i) and (iii). Therefore, applicants should not rely upon decisions relating to the "unavoidable delay" standard of 35 U.S.C. 133 as controlling in a request to reinstate reduced patent term adjustment on the basis of a showing that the applicant was unable to respond within the three-month period in spite of all due care.

Petitioner has not met this higher standard. To avoid entry of a period of reduction for applicant delay within the meaning of §1.704(b), applicants should have filed a response to the Office action mailed November 3, 2006 on or by February 3, 2007. Petitioner's arguments have been considered, but not found persuasive that applicant was "unable to respond" within the three month period "in spite of all due care." The delay in filing the reply from February 4, 2007 until March 1, 2007 was not in spite of all due care.

Petitioner generally states that they promptly began action on a draft amendment shortly after receiving the November 3, 2006 Office action. However, no amendment was filed. Moreover, petitioner does not detail the efforts undertaken to this end in November and December of 2006. Rather, petitioner details their inability to reach the examiner by telephone during January and February of 2007 due to the examiner being on leave from the Office due to disability; that subsequent to the ending of the three-month period, on February 13th and 14th, a snow and ice storm occurred in the Washington DC area precluding their travel and leading to cancellation of the interview with the newly assigned examiner; and that the interview with the newly assigned examiner did not occur until February 21, 2007. An amendment was filed more than a week thereafter on March 1, 2007.

Petitioner makes clear that they delayed in filing a reply until after they could conduct an interview with an Examiner. Applicants were, of the opinion, they were not able to effectively respond so as to achieve the most desirable result, i.e., the issuance of a Notice of Allowance, without conducting the interview with the Examiner.

This was not out of applicants' control. Applicants were not unable to respond. No natural disaster occurred which rendered applicant unable to reply within the original three-month period. The storm cited did not even occur until February 13, 2007, ten days after the end of the three-month period. Moreover, notwithstanding the storm, applicants have not shown that they were even prepared to file a response on February 13, 2006.

Furthermore, applicants could have filed a written response on or before February 3, 2007. Instead of submitting a written

response to the non-final Office action, applicants state they telephoned the Patent Office a total of eighteen times. Applicants chose to delay filing of a reply until they could file a response that would achieve what they described as the "ordinary and desired outcome." As a consequence, 26 days of patent term adjustment were lost.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is seventy-three (73) days.

The Office acknowledges submission of the $200 fee set forth in 37 CFR 1.18(e) and the $400.00 fee set forth in 37 CFR 1.18(f). No additional fees are required.

The application is being forwarded to the Publications Division for issuance of a patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

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